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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,625	06/26/2003	Shigeki Matsubara	KAS-183	4454

7590 08/18/2008
MATTINGLY, STANGER & MALUR, P.C.
SUITE 370
1800 DIAGONAL ROAD
ALEXANDRIA, VA 22314

EXAMINER

RAMILLANO, LORE JANET

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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08/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/603,625

Applicant(s)

MATSUBARA ET AL.

Examiner

LORE RAMILLANO

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Claims

1. In applicant's reply filed on 4/30/08, applicant amended claims 1 and 4; and added new claim 6. Claims 1-6 are pending and under examination in the application.

Response to Amendment

Claim Rejections - 35 USC § 112

2. The rejections of claims 4-5 under 35 U.S.C. 112, second paragraph, is withdrawn. In light of applicant's amendments, a new rejection follows.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation of the "analysis unit setting section" appears to be subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The functional language following the recitation of the "analysis unit setting section" appears to be reciting the function of the recited, "central control device." Furthermore, it does not appear that the "analysis unit setting section" is referring to the "setting of the analysis unit" in figure 3

since applicant indicated in claim 3, for example, that this was the "mode setting screen." Therefore, the "analysis unit setting section" does not appear to be supported by the original disclosure.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is indefinite because of the "analysis unit setting section" limitation. What structural limitation is applicant referring to?

Prior art rejection

7. In light of applicant's amendment, a new rejection follows.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-6** are rejected under 35 U.S.C. 102(b) as being anticipated by Ohishi et al. ("Ohishi," US 6019945).

Ohishi discloses an automatic analyzer comprising:

a conveying unit for conveying a sample (i.e. 20, Fig. 1);

plural analysis units for analyzing the sample conveyed by said conveying line (i.e. 3A, 3B, and 3C, Fig. 1);

analysis unit setting section for setting analysis units to an active mode or a power-off enable mode (i.e. "operator unit," 42, fig. 1);

a central control device for controlling said conveying unit and said analysis units (i.e. "control unit," column 9, lines 43-50); and

an information network (i.e. "host control computer," 40, fig. 1) connecting said central control device and said analysis units,

wherein said central control device has a function separating one of said analysis units from said information network to enable shut off of a power supply of said one of said analysis units while other analysis units are maintained connected to said information network (i.e. column 9, line 43 to column 10, line 23).

Ohishi further discloses an automatic analyzer comprising: a mode setting screen for displaying said conveying unit and said analysis units (column 4, lines 47-50), and for specifying any one of displayed conveying line and a displayed analysis unit to be separated by said central control device from said information network of said central control device to shut off a power supply of said conveying unit or said analysis unit. (i.e. column 9, line 43 to column 10, line 23).

In addition, Ohishi discloses that the mode setting screen repeats an operation for specifying any one of said conveying line and said analysis unit, so that said central control device switches between enabling shutting off of said power supply of said conveying unit or said analysis unit to separate said conveying unit or said analysis unit

from said information network, and again turning on said power supply of said conveying unit or said analysis unit to connect said conveying unit or said analysis unit to said information network. (i.e. column 9, line 43 to column 10, line 23).

Also, Ohishi discloses that the central control unit is responsive to said mode setting screen specifying any one of the sections displayed on said display means to thereby perform switching between the separation of the specified section from the control of said central control device and the reconnection thereof to said central control device (i.e. column 9, line 43 to column 10, line 23).

Response to Arguments

10. Applicant's arguments filed on 4/30/08 have been fully considered but they are not persuasive.

In response to applicant's argument that Ohishi is silent in its disclosure with respect to a discussion regarding the separation of the analysis unit from an information network, examiner respectfully disagrees. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. Here, Ohishi discloses the structural limitations recited in claims 1-6, as indicated in the above paragraph. Ohishi appears to be capable of performing the functional language recited in these claims, i.e. "central control device has a function separating one of the analysis units from the information network", because Ohishi discloses in, i.e. col. 10, lines 1-23, that the control unit has the ability of disassociating the analysis unit with the abnormality from the host control computer (40) by instructing another analysis unit to take over the abnormal

analysis unit's operation. The host control computer is inherently involved in this disassociation function since Ohishi discloses in i.e. col. 4, lines 32-50 that this host control computer has the ability to execute operation control of each analysis portion, the rack transfer system, and other necessary portions in the system.

In response to applicant's argument that Ohishi does not describe how to turn off (and on) a power source for one of the analysis units, examiner respectfully disagrees. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. Here, Ohishi discloses the structural limitations recited in claims 1-6, as indicated in the above paragraph. Ohishi appears to be capable of performing the functional language recited in these claims, i.e. "turning off and on a power supply of one of the analysis units", because Ohishi discloses in, i.e. col. 9, lines 51-67, that the operator can instruct each of the analysis units to start to stop (i.e. turn off and on).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORE RAMILLANO whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7420.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

Lore Ramillano
Examiner
Art Unit 1797